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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,420	02/12/2004	Janaki Kumar	13906-172001 / 2004P00084	4320
32864	7590	05/25/2010		
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
WASEL, MOHAMED A				
ART UNIT		PAPER NUMBER		
2454				
NOTIFICATION DATE		DELIVERY MODE		
05/25/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### Office Action Summary

**Application No.**

10/777,420

**Applicant(s)**

KUMAR, JANAKI

**Examiner**

MOHAMED WASEL

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
- Paper No(s)/Mail Date 2/12/2004

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

This action is responsive to application filed on February 12, 2004. Claims 1-18 are pending and presented for examination.

#### Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

**The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**

It is recommended to amend the Abstract of the disclosure to read "A computer-readable medium containing therein instructions..." instead of "**One embodiment of the invention provides a computer-readable medium containing therein instructions...**". Appropriate corrections are required.

#### Drawings

The drawings are objected to because the newly submitted drawings Figures 1-4, submitted on 3/1/2004 need to be marked as "**Replacement Sheets**". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views

of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15, 17 and 18 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to a computer-readable medium, which can either be storage media "memory" or transmission media. While storage media qualify as a manufacture patent-eligible subject matter, transmission media are non-statutory subject matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal. Applicant is advised to direct the claim language to a non-transitory, tangible computer readable storage medium, which possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture patent-eligible subject matter.

Claims 2-14 are rejected under the same rationale as claim 1 due to their dependency.

Claim 15 is directed a graphical user interface (**software program**), which would have reasonably interpreted as software alone and thus lack the necessary physical articles or objects to

constitute a machine or a manufacture within the meaning of 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, it fails to fall within a statutory category. They are, at best, functional descriptive materials per se.

Appropriate corrections are required to overcome the 101 rejection.

Claim 17 is rejected under the same rationale and reasoning as claim 1.

Claim 18 is directed to a system for providing a graphical user interface, which also may be reasonably interpreted as software alone and thus lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, it fails to fall within a statutory category. They are, at best, functional descriptive materials per se.

Appropriate corrections are required to overcome the 101 rejection.

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites in the preamble of the claim **"the method comprising, wherein the system is programmed to.."**, which renders the claim indefinite because is unclear what the claim pertains to.

Appropriate correction is required where applicable.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaw et al (hereinafter referred to as "Shaw"), US Patent No. 6,282,565.

1. As per claim 1, Shaw teaches a computer-readable medium containing therein instructions that, when executed, generate on a display device a graphical user interface (GUI) (**col. 4 lines 60-67; GUI**) for creating or revising a rule that contains a condition and an action to be taken when the condition is satisfied (**col. 1 lines 35-46**), the GUI comprising:

a rule-editing area (**Fig. 2A, col. 4 lines 60-67**);

first and second user-selectable elements, wherein the rule-editing area is configured to accept user input to create or revise the condition of the rule upon user selection of the first element, and wherein the rule-editing area is configured to accept user input to create or revise the action of the rule upon user selection of the second element (**Fig. 2A, col. 4 lines 39-67**); and

a rule-preview area configured to provide a display of a user-understandable representation of both the condition and the action (**Fig. 2A, col. 4 lines 60-67**).

2. As per claim 2, Shaw teaches the computer-readable medium wherein the rule-preview area is configured to provide a display of a user-understandable representation of both the rule condition and the rule action in a read-only format (**Fig. 2A, col. 4 lines 60-67**).

3. As per claim 3, Shaw teaches the computer-readable medium wherein the rule contains at least two conditions, and wherein the rule-editing area is configured to accept user input to create or modify any the conditions upon user selection of the first element (**col. 4 lines 39-67; attribute**).

4. As per claim 4, Shaw teaches the computer-readable medium wherein the rule contains at least two actions, and wherein the rule-editing area is configured to accept user input to create or modify any of the actions upon user selection of the second element (**col. 4 lines 39-67; action**).

5. As per claim 5, Shaw teaches the computer-readable medium wherein the condition includes an attribute name, an operator, and an attribute value (**col. 4 lines 60-67**).

6. As per claim 6, Shaw teaches the computer-readable medium wherein the rule-editing area contains:

a first menu having a set of user-selectable options for determining the attribute name of the condition (**col. 4 lines 39-67**);

a second menu having a set of user-selectable options for determining the operator of the condition and a text-entry field to accept user input for determining the attribute value of the condition (**Fig. 3, col. 10 lines 18-51**).

7. As per claim 7, Shaw teaches the computer-readable medium wherein the action includes an action name and an action value (**col. 13 line 44 – col. 14 line 14**).

8. As per claim 8, Shaw teaches the computer-readable medium wherein the rule-editing area contains:

a menu having a set of user-selectable options for determining the action name of the action and a text-entry field to accept user input for determining the action value of the action (**Fig. 2A, col. 4 lines 39-67**).

9. As per claim 9, Shaw teaches the computer-readable medium wherein the action further includes an 15 attribute name and an attribute value (**col. 4 lines 39-67**).

10. As per claim 10, Shaw teaches the computer-readable medium wherein the first user-selectable element is adjacent to the second user-selectable element (**col. 10 lines 41-51**).

11. As per claim 11, Shaw teaches the computer-readable medium wherein the first and second user-selectable elements are each either user-selectable button or user-selectable text elements (**col. 4 lines 60-67**).

12. As per claim 12, Shaw teaches the computer-readable medium wherein the first and second user-selectable elements are each graphical tabs (**col. 14 lines 42-67**).

13. As per claim 13, Shaw teaches the computer-readable medium wherein the rule may be used to process textual information (**col. 4 lines 28-47**).

14. As per claim 14, Shaw teaches the computer-readable medium wherein the rule may be used to process textual information contained in an email message (**col. 4 lines 28-47**).

15. Claims 15-18 are rejected under the same rationale as claim 1.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Wasel whose telephone number is (571) 272-2669. The examiner can normally be reached on Mon-Fri (8:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mohamed Wasel/  
Patent Examiner, Art Unit 2454  
May 20, 2010